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09/449,159	11/24/1999	SHAWN D. ABBOTT	30074.26US11	5935

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EXAMINER

JACKSON, JENISE E

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/449,159

Applicant(s)

ABBOTT ET AL.

Examiner

Jenise E Jackson

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-89 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-89 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-9, 13-25, 29-40, 44-50, 53-57, 60-63, 65-67, 71-89, are rejected under 35

U.S.C. 102(e) as being anticipated by Rallis.

3. As per claims 1, 18-19, 35, 49, 54-55, 61, 71, 77, 80, Rallis et al. discloses compact personal token(20)(see fig. 1B, sheet 1), a USB-compliant interface releaseably(14) coupleable to a host processing device(10)(see fig. 1A, sheet 1); a memory; a processor, communicatively coupled to the memory and communicatively, coupleable to the host processing device via the USB-compliant interface(see fig. 1A, 1B, sheet 1, col. 3, lines 4-17), the processor for providing the host processing device conditional access to data storable in the memory(see col. 2, lines 58-66); and a user input device, communicatively coupled to the processor by a path distinct from the USB-compliant interface, for accepting an input signaling authorization of a processor operation(see col. 2, lines 63-67, fig. 1A, sheet 1). The Examiner asserts that access to private data is secured, because only the authorized user with the Pin can access the host computer system.

4. As per claims 2, 23, 38, Rallis discloses wherein the path is entirely internal to the token(see col. 1, lines 62-67).

Art Unit: 2131

5. As per claim 3, 9, 19, Rallis discloses, wherein the processor operation requires access to private data stored in the memory(see col. 1, lines 61-67).
6. As per claim 4, Rallis discloses wherein the private data is designated as requiring authorization before access by an associated identification stored in the memory(see col. 1, lines 61-67, col. 2, lines 62-66).
7. As per claims 5, 24, 39, 53, 60, 65, 73, Rallis discloses wherein the input device includes at least one pressure-sensitive device actuatable from an exterior surface of the token(see col. 5, lines 46-50).
8. As per claims 6, 25, 40, 66, Rallis et al. discloses wherein the input device comprises at least one push-button switch(see col. 5, lines 46-50).
9. As per claims 7, 56, 74, 88, Rallis et al. discloses an output device, communicatively coupled to the processor by a second path distinct from the USB-compliant interface, for prompting a user to provide an authorization of a processor operation(see col. 1, lines 60-67, col. 2, lines 1-7).
10. As per claims 8, 21, 36, 75, Rallis et al. discloses wherein the path and the second path are a common path(see col. 2, lines 3-10).
11. As per claims 13, 29, 44, Rallis et al. discloses wherein the output device provides an alphanumeric message indicating that user input is required(see col. 1, lines 61-63).
12. As per claims 14, 30, 45, Rallis et al. discloses wherein the alphanumeric message identifies the processing operation(see col. 1, lines 64-67, col. 2, lines 1-7).
13. As per claims 15, 31, 46, Rallis et al. discloses wherein the alphanumeric message identifies a private key(see col. 2, lines 1-7).

Art Unit: 2131

14. As per claims 16-17, 32-33, 47-48, Rallis et al. discloses wherein the memory is configured to store the data in at least one file, the file belongs to a file type set comprising a data file type for storing non-private data; a key file type for storing the private data; the access to the file in the memory is classifiable according to an access type set including: a read access type permitting data to be read from the file; a write access type permitting data to be written to the file; and the processor provides the conditional access to the memory according to the file type and the access type(see col. 4, lines 51-65, col. 5, lines 1-8).

15. As per claim 20, Rallis discloses wherein the output device is communicatively coupled to the processor by a second communication path distinct from the USB-compliant interface(see fig. 1A, sheet 1).

16. As per claims 22, 37, Rallis discloses wherein the step of determining if the processor requires access to a private key stored in the token includes, determining which data stored in the memory is affected by the processor operation; and determining whether the data affected by the processor operation is associated with an identification designating the data as a private key(see col. 1, lines 61-67, col. 2, lines 1-10).

17. As per claim 34, Rallis et al discloses wherein the command is an authorization request including a challenge value, and the processor operation is a hash function using the challenge value and the private data(see col. 2, lines 1-15).

18. As per claims 50, 57, Rallis et al. inherently discloses wherein the user input device includes a character input device, because Rallis discloses a user has to enter a pin(see col. 1, lines 62-67).

Art Unit: 2131

19. As per claim 62, Rallis et al. discloses wherein the user input device is configured to control an operation of the processor(see col. 2, lines 59-67) .

20. As per claim 63, 72, 83, 87, Rallis et al. discloses wherein the operation includes an operation selected from the group: an encryption operation; and a decryption operation(see col. 2, lines 1-10).

21. As per claims 76, 84, 89, limitations have already been addressed(see claims 10-12).

22. As per claim 78, Rallis discloses wherein the user output device is coupled to a power signal of the USB-compliant interface(see col. 5, lines 44-57).

23. As per claim 79, Rallis discloses wherein the user output device is coupled to a data signal of the USB-compliant interface(see col. 5, lines 44-57).

24. As per claims 56, 81, Rallis discloses, wherein the user output device is coupled to the processor by a path distinct from the USB-compliant interface(see col. 6, lines 7-22).

25. As per claim 82, Rallis discloses wherein the user output device is configured to indicate the operation of the processor(see col. 6, lines 7-22).

26. As per claims 67, 85, Rallis discloses further comprising an input device, communicatively coupled to the processor by path distinct from the USB-compliant interface, for providing information for the operation of the processor(see fig. 1A, sheet 1).

27. As per claim 86, Rallis discloses authorizing access to private data stored in a token having a processor communicatively coupleable to a host processor via a Universal Serial Bus (USB) interface, comprising the steps of: accepting a command in the token invoking a processor

Art Unit: 2131

operation; and signaling the processor operation via a user output device(see col. 1, lines 62-67, col. 2, lines 62-66, see fig. 1A, sheet 1).

***Claim Rejections - 35 USC § 103***

28. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

29. Claims 10-12, 26-28, 41-43, 51-52, 58-59, 64, 68-70, are rejected under 35 U.S.C. 103(a) as being unpatentable over Rallis et al.

30. As per claims 10, 26, 41, 68, the Examiner takes Official Notice that having an output device that is a light-emitting device is well-known, because it allows the user to know that activity is being performed on the device.

31. As per claims 11, 27, 42, 70, the Examiner takes Official Notice that having an output device that includes at least one aural reproduction device, is well-known, the motivation is that it allows the user to hear that activity is being performed on the device.

32. As per claims 12, 28, 43, 69, the Examiner takes Official Notice that having an output device that includes at least one liquid crystal display (LCD), is well-known, because it allows the activity to be displayed on a screen.

33. As per claim 64, the Examiner takes official notice that it is well-known in the art to use a digital signature operation using a private key stored in the memory, the motivation, is that the digital signature verifies the sender.

Art Unit: 2131

34. As per claims 51-52, 58-59, the Examiner takes Official Notice that it would have been obvious to have the character input device that includes a wheel having an input position for each character in an input character set, the Examiner asserts that by having a wheel instead of a keypad, makes it much easier for the user to enter the pin.

***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenise E Jackson whose telephone number is (703) 306-0426. The examiner can normally be reached on M-Th (6:00 a.m. - 3:30 p.m.) alternate Friday's.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (703) 305-9648. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-0040 for regular communications and (703) 308-6306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

  
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September 28, 2003

  
AYAZ SHEIKH  
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